

REMARKS

This Amendment is responsive to the Office Action identified above, and is further responsive in any manner indicated below.

IMPROPER REFUSAL TO RESTART PERIOD FOR RESPONSE

Applicant timely filed a Request for Withdrawal of Finality and Restart of the Period for Response in view of the defective 5 November 2003 Office Action and the improper finality thereof, and although an USPTO Communication dated 9 January 2004 indicated that the improper finality had been withdrawn, the period for response to the 5 November Action was not restarted, and Applicant notes the Examiner's improper refusal to restart the period for response. A Petition to the Commissioner Under 37 CFR §1.181 was timely filed, and since no Communication has yet been received by Applicant remedying the Examiner's improper examination procedure in response to the formal §181 Petition, Applicant incorporates the entire contents of the Petition herein by reference.

In view of the Examiner's improper examination procedure, Applicant submits that this Amendment is a *bona fide* and complete response to the 5 November 2003 Action.

EXAMINER INTERVIEWS ACKNOWLEDGED

The following pertains to the personal and telephonic Examiner Interviews held by and between primary Examiner Bradley L. Sisson and Applicant's representative Paul J. Skwierawski, Reg. No. 32,173, *i.e.*, a personal Interview

conducted at the Examiner's Office on 9 September 2003, and a telephonic Interview conducted on 29 September 2003. In view of the Interview Summary Records mailed 15 September and 29 September 2003, the required Statements of Substance for both Interviews were timely filed by Applicant on 15 October 2003. Applicant and the undersigned representative again gratefully acknowledge such Interviews, and again thank the Examiner. Ones of the present pending claims under consideration have been amended in a manner believed consistent with amendments discussed during the aforementioned Interviews.

PENDING CLAIMS

Claims 1-35 were pending, with Claims 1-11 and 18-29 under consideration and subject to examination in the Office Action mailed 05 November 2004. Unrelated to any prior art, scope adjustment or rejection, appropriate claims have been amended, deleted or added in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, such changes are simply refocused claims in which Applicant is presently interested. At entry of this paper, Claims 1-11 and 18-29 remain pending in the application for further consideration and examination.

REJECTIONS UNDER 35 USC §103 - TRAVERSED

The 35 USC §103 rejection of Claims 1-11 and 18-29 as being unpatentable over Pinkel *et al.* (US 5,830,645 A) in view of Stern (US 5,981,956 A) and Rosenberg (US 4,538,613 A) is respectfully traversed. Such rejection is rendered obsolete by the present clarifying amendments to Applicant's claims, and

accordingly, traversal arguments are not appropriate at this time. However, Applicant respectfully submits the following to preclude renewal of any such rejections against Applicant's clarified claims (or new claims).

All descriptions of Applicants disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed.

In order to properly support a §103 obviousness-type rejection, the reference not only must suggest the claimed features, but also must contain the motivation for modifying the art to arrive at an approximation of the claimed features. However, the cited art does not adequately support a §103 obviousness-type rejection because it does not, at minimum, disclose (or suggest) the following limitations of Applicant's clarified claims as discussed in comments from Applicant's foreign representative in support of the patentability of Applicant's invention.

With respect to the difference between the references and the present invention, in the present invention, a plurality of multi-spot excitation lights are simultaneously irradiated to a plurality of DNA probe cells of a DNA chip to generate fluorescent lights from any fluorescently labeled target DNA hybridized to ones of the DNA probes of the plurality of DNA probe cells and the generated and separated fluorescent lights are simultaneously detected with a plurality of sensors each corresponding to each of the DNA probe cells irradiated. Further, in the present invention, a plurality of DNA probe cells are simultaneously irradiated with a sheet-

shaped excitation light and the generated and separated fluorescent lights are simultaneously detected with a plurality of sensors each corresponding to each of the DNA probe cells irradiated.

As to Pinkel *et al.*, the Examiner states that a similar inspecting method is disclosed in column 12, second full paragraph. However, in Pinkel *et al.*, the sample to be inspected is an unknown sample. The sample is not the DNA probe. In Pinkel *et al.*, there is no disclosure that a plurality of DNA probe cells are irradiated simultaneously with multi-spot exciting lights, and that the generated and separated fluorescent lights are simultaneously detected with a plurality of sensors each corresponding to each of the DNA probe cells irradiated.

The reference to Stern relates to an art of single spot scanning system. There is no disclosure that a plurality of DNA probe cells are irradiated simultaneously with multi-spot exciting lights.

The reference to Rosenberg relates to an operation tool using a laser beam through optical fibers. It does not relate to an inspection of DNA probe. There is no disclosure that a plurality of DNA probe cells are irradiated simultaneously with multi-spot exciting lights, and that the fluorescent lights are detected with a plurality of sensors, each corresponding to each spot of the multi-spot exciting lights.

As is clear from the above, the present invention is very different from the references. Accordingly, the present invention should be regarded as being patentable over the references.

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §103 obviousness-type rejection of Applicant's claims.

Accordingly, reconsideration and withdrawal of such §103 rejections, and express written allowance of all of the rejected claims, are respectfully requested.

SPECIFIC TRAVERSAL OF “OFFICIAL NOTICE”

Office Action comments in support of the art rejection assert that certain claimed features were well known in the art, *i.e.*, without providing supportive art references for such assertion. With regard to such assertion of apparent judicial (*i.e.*, Examiner) notice of common knowledge or well-known prior art, attention is directed to MPEP §2144.03 which states, "If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position."

Furthermore, in the recent decision in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), the Court, in reversing an obviousness rejection, indicated that deficiencies of the cited reference cannot be remedied with conclusions about what is “basic knowledge” or “common knowledge.” The Court pointed out:

The Examiner’s conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of reference, simply to “[use] that which the inventor taught against its teacher.”...Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.
(emphasis added)

Accordingly, in view of Applicant's traversal in this regard, and in accordance with the provisions of MPEP §2144.03, Applicant respectfully requests that a documentary proof be cited to explicitly show that such features were explicitly known in the art, or alternatively, Applicant respectfully requests withdrawal of all rejections based upon such unsupported judicial notice. Further, at this point, it is respectfully submitted as a reminder that, if new art is now cited against any of Applicant's unamended claims, then it would not be proper to make a next Action final.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

EXAMINER INVITED TO TELEPHONE

The Examiner is invited to telephone the undersigned at the local D.C. area telephone 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

Attached hereto is a Petition for Extension of Time Under 37 CFR §1.136 and Form PTO-2038 authorizing payment of the requisite Petition fee (Code 1251). To whatever other extent is actually appropriate, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. Please charge any shortage in the fees due in connection with the filing of this paper to ATS&K Deposit Account No. 01-2135 (referencing Case No. 500.39147X00).

Respectfully submitted,



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Attachments:
Petition For Extension Of Time
Form PTO-2038 (Fee Code 1251)